



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,992	09/05/2003	Richard C. Walker	110273.302US1	6692
24395	7590	05/13/2005	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP THE WILLARD OFFICE BUILDING 1455 PENNSYLVANIA AVE, NW WASHINGTON, DC 20004			JEFFERY, JOHN A	
			ART UNIT	PAPER NUMBER
			.3742	

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/654,992	<b>Applicant(s)</b> WALKER, RICHARD C.	
	<b>Examiner</b> John A. Jeffery	<b>Art Unit</b> 3742	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/738,901.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20050127</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Revised Amendment Practice Under 37 CFR 1.121***

Applicant is reminded of the revised amendment practice under 37 CFR 1.121 effective July 30, 2003. The seven permissible status identifiers set forth in 37 CFR 1.121(c) are:

**(Original);**

**(Currently amended);**

**(Canceled);**

**(Previously presented);**

**(New);**

**(Not entered); and**

**(Withdrawn).**

Accordingly, in claims 1 and 2, "(Currently Presented)" must be changed to "(Currently amended)."

### ***Abstract***

The abstract of the disclosure is objected to because of the following informalities:

(1) The first sentence is incomplete. Accordingly, it must be rewritten -- preferably as two sentences for clarity.

(2) The acronyms "PFN/TRAC/FACT" must be spelled out for clarity. Correction is required. See MPEP § 608.01(b).

### ***Drawing Objections***

The drawings remain objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims.

(1) Although there is reference to the strip or wire with bonding material in replacement Fig. 1, the figure still does not adequately and clearly show the metal wire or metal strip structure coated with the liquefiable substance. To best show this important structure, an enlarged cross-sectional figure of the metal and coating with appropriate hatching (i.e., metal and insulation) is needed. See Figs. 1-3 of Baggott (US 2,662,045) for a good example. Moreover, the enlargement should focus solely on the metal strip or wire and its coating.

(2) Replacement Figs. 1 and 2: Both figures actually correspond to original Figs. 30 and 29 respectively. Applicant must renumber the replacement figures accordingly.

(3) Replacement Fig. 1: All three subfigures must each be assigned a separate figure number and so referenced in the specification. For example, each subfigure should be designated "Fig. 30," "Fig. 30A," and "Fig. 30B" respectively.

Applicant is reminded to amend the specification accordingly in conjunction with the drawing change. No new matter should be entered.

Art Unit: 3742

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 1-3 are objected to because of the following informalities:

Claims 1 and 2: For the reasons set forth in the first paragraph of this office action, status identifiers "(Currently Presented)" must be changed to "(Currently amended)."

Claim 1: In line 3, "coasted" must be changed to "coated."

***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 USC 102(b) as being anticipated by Baggott (US 2,662,045). Baggott (US 2,662,045) discloses a system for bonding comprising thin metal strip 13 coated with plastic resin 12 that melts when current is applied to the metal strip. "Security switch" CS permits the "shorted condition of the power source through the metal strip" as claimed in claim 2. Switch CS also fully meets the "security trigger circuit" limitation of claim 3, as well as the "activation system" limitation of claim 1 (i.e., the heater comprising the metal strip is "activated" upon closing the switch).

Moreover, the scope and breadth of the term "secure sealing, unsealing, and/or bonding" recited in the preamble of claim 1 does not preclude the "secure" bonded joint obtained with Baggott's system. Note Baggott's characterizing the bond between the pieces of wood as "a strong finished joint" in col. 3, lines 3-5 (emphasis added). Such a strong bond is inherently physically "secure" given the term's broadest reasonable interpretation.

Regarding the last two lines of claim 1 (describing how the coated metal strip is made), the limitation merely recites a product by process limitation. It is well settled that reciting how a product is made does not further limit the structure of the product itself. "[E]ven though product-by-process claims are limited by and defined by the process,

Art Unit: 3742

determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted.) Here, the structure of Baggot's coated metal strip fully meets the coated strip of claim 1 notwithstanding Baggot's silence as to exactly how the strip is made.

### ***Response to Arguments***

Applicant's arguments have been considered but are deemed to be moot in view of the new grounds of rejection.

### ***Final Rejection***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3742

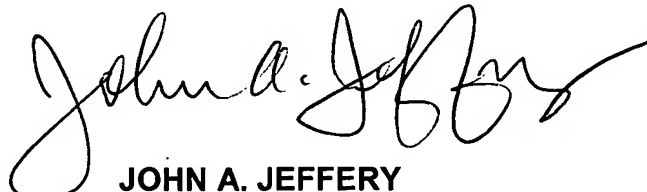
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. Jeffery whose telephone number is (571) 272-4781. The examiner can normally be reached on Monday - Thursday from 7:00 AM to 4:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robin Evans, can be reached on (571) 272-4777. All faxes should be sent to the centralized fax number at (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**JOHN A. JEFFERY**  
**PRIMARY EXAMINER**

5/11/05